

### REMARKS/ARGUMENTS

The present application is under appeal. Applicants have filed an Appeal Brief, and an Examiner's Answer was mailed February 20, 2008.

The Examiner's Answer set forth new grounds of rejection. As provided under 37 CFR § 41.39(b), Applicants have the right to reopen prosecution if an examiner's answer contains a new ground of rejection. Accordingly, Applicants submit this reply under 37 CFR § 1.111 to reopen prosecution. As provided under 37 CFR § 41.39(b)(1), the application will be reconsidered by the Examiner under the provisions of 37 CFR § 1.112, and Applicants respectfully request such action.

#### Rejection of Claims 1-4 under 35 U.S.C. § 101

In the Examiner's Answer, the Examiner set forth a new ground of rejection rejecting claims 1-4 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The following addresses this new ground of rejection.

Applicants respectfully traverse the rejection. The Examiner's Answer states that such claims fail to fall within a statutory category of invention because they are directed to a program itself. However, Applicants point out that claims 1 - 4 are directed to a computer program product. The M.P.E.P. states: "In choosing such expansive terms as "manufacture" and "composition of matter," modified by the comprehensive "any," Congress plainly contemplated that the patent laws would be given wide scope." M.P.E.P. 2106.IV.A The claimed invention also includes a specifically defined set of means.

In fact, the Examiner asserts that the invention claimed in claim 1 is found in the description of another patent (the Guheen reference), which seems at least somewhat inconsistent with the assertion that such claim fails to set forth a statutory category of invention.

In any event, in order to expedite the present application to allowance of the application, Applicants have made clarifying amendments to claims 1 - 4. Claim 1 now recites, for example: "A computer program product on a network-connected device." Support for the amendment is found for example in the Applicants' specification on page 5, lines 6 et seq.

It is believed that a computer program product on a network-connected device is clearly within a statutory category of invention, particularly given that a network-connected device is a

tangible, concrete device and is also a statutory machine. See 35 U.S.C. § 101 (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title”).

Thus, it is believed that the rejection of claims 1 - 4 under 35 U.S.C. § 101 has been overcome and removal of such rejection is respectfully requested.

Rejection of Claims 1 - 14 under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection under 35 U.S.C. § 102(e) for at least the reasons set forth in Applicants’ prior response and in Applicants’ Appeal Brief.

In the Responses to Argument in the Examiner’s Answer in the appeal, the Examiner points to some portions of the Guheen reference in response to Applicants’ arguments. Examiner’s Answer, page 6. However, these cited portions of the Guheen reference still fail to cure Guheen’s failure to anticipate the claimed invention. Applicants point out, in this regard, that, with respect to a reference cited for anticipation under 35 U.S.C. §102, the MPEP requires:

The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test...

MPEP 2131 (Anticipation -- Application of 35 USC 102(a), (b), and (e), subsection entitled “To Anticipate a Claim, the Reference Must Teach Every Element of the Claim”) (emphasis added).

The Examiner’s Answer only points to disconnected discussions in the Guheen reference. However, the Examiner has not shown a teaching of the complete invention, as claimed, with the elements arranged as required by the claim, as required by MPEP 2131. The Examiner’s citations to disconnected discussions in the Guheen reference fail to teach the claimed arrangement of elements. For example, the Office Actions and Examiner’s Answer have failed to establish a teaching, of the following, as arranged in this claim:

1. A computer program product on a network-connected device including:
  - means for comparing a URL, title and/or content of an online site viewed by a user with a first index of keywords relating to a plurality of subject matter categories, to determine any subject matter categories to which the online site relates;

means for cross-referencing any determined subject matter categories with a second index of alternative online sites categorised by subject matter, in order to determine any alternative online sites in the same or similar category; and  
means for displaying any determined alternative online sites to the user.

Claim 1 (as amended).

Thus, it is believed that the rejection of claims 1 - 14 under 35 U.S.C. § 102(e) should be removed and such action is respectfully requested.

New Claims 34 - 37

New claims 34 - 37 have been added. Such claims are believed patentable. Review and approval thereof are respectfully requested.

### CONCLUSION

Applicants submit that the instant application is in condition for allowance. Should the Examiner have any questions, the Examiner is requested to contact the undersigned attorney.

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. 23-2415 (Docket No. 25720-702).

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI

Date: April 21, 2008

  
\_\_\_\_\_  
Kurt W. Carlson, Reg. No. 46,601

650 Page Mill Road  
Palo Alto, CA 94304  
(650) 493-9300  
Customer No. 021971